



Xerox Docket No. D/99620

PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Michelle Q. Wang BALDONADO et al.

On Appeal from Group: 2176

Application No.: 09/461,040

Examiner: M. NGUYEN

Filed: December 15, 1999

Docket No.: 104323

For: SYSTEMS AND METHODS FOR ANNOTATING OBJECTS WHEN THE ANNOTATION
DEVICE DIFFERS FROM THE VIEWING DEVICE

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto is our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Five Hundred Dollars (\$500.00) in payment of the Brief fee under 37 CFR 41.20(b)(2). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,

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Date: September 29, 2005

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BRIEF ON APPEAL

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Appeal from Group 2176

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I. REAL PARTY IN INTEREST

The Real Party in Interest for this Appeal and the present application is Xerox Corporation, by way of an assignment recorded in the U.S. Patent and Trademark Office at Real 010451, Frame 0449.

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no pending or prior Appeals or Interferences, known to Appellants, Appellants' representative or the assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 1-37 are pending, finally rejected and on appeal.

No claims are allowed, and no claims are objected to only for being dependent from a rejected base claim, but otherwise allowable.

No claims are withdrawn from consideration.

No claims are canceled.

IV. STATUS OF AMENDMENTS

No Amendments have been filed subsequent to the close of prosecution by the May 18, 2005 Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to an annotation system that associates annotations with at least one object, the annotation system being described in the specification, for example, at page 5, line 25 – page 7, line 29, page 10, lines 14-30, page 17, lines 7-22, and shown in Figs. 1 and 5.

The annotation system includes a display (viewing) device (20) for viewing for viewing an object (210, 400, 500, 810), a search circuit (210), an annotation device (100), and a search circuit (190). The display device (20) is distinct from the annotation device (100). The search circuit (190) locates the search circuit (210) to be annotated and provides an object identifier that corresponds to the search circuit (210). The annotation device (100) enables a user to make an annotation independent of the search circuit (210).

The annotation device (100) includes an input device (10) that inputs the annotation and an annotation linking circuit (150) that establishes a link (25) to associate the annotation with the search circuit (210). The annotation device (100) also includes a database (310) that stores the object identifier, the annotation and the link (25), as well as a synchronize circuit (160) that associates the annotation with the search circuit (210) based on the link (25) and the object identifier. The user makes the annotation using the annotation device (100) while viewing the search circuit (210) using the distinct display device (20). Upon synchronization by the synchronize circuit (160), the annotation transfers to the search circuit (210).

Independent claims 14 and 26 are directed to a method and an information storage medium that stores a computer program, respectively, for associating annotations with at least one object. The method and program are described in the specification, for example, at page 18, line 17 – page 19, line 21, and shown in Figs. 9A-9B.

The object annotation process includes several steps. For example, the process searches for the object (810) to annotate (at step S110), and obtains an object identifier for the object (810) by retrieval (at step S130) and reception (at step 170).

The process continues to generate an annotation (at step S200) using the annotation device (100) and the input device (10). Concurrently, the process displays the object (810) (at step S240) using the display device (20). Both input and display devices (10, 20) are distinct from the annotation device (100). The process continues to establish the link (25) that associates the annotation with and transfers the annotation to the object (810) (at step S270).

The method is further described in Figs. 10-12 for object annotation (step S270) that includes searching the object for a text portion to be annotated (step S1020), establishing the object identifier with a portion location (step S1040) and establishing the identifier associated with the portion location (step S2030).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following ground of rejection are presented for review:

Claims 1-37 are rejected as anticipated under 35 U.S.C. §103(a) by U.S. Patent No. 6,173,287 to Eberman et al. ("Eberman") in view of "Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations", by Schilit et al., *CHI-98*, April 1998 ("Schilit").

VII. ARGUMENT

A. Claims 1-37 Would Not Have Been Obvious Over Eberman in view of Schilit

The May 18, 2005 Final Office Action rejects claims 1-37 under 35 U.S.C. §103(a) over Eberman in view of Schilit. Specifically, the May 18, 2005 Final Office Action asserts, at pages 3-4, that Eberman discloses a method for associating annotations, including the searching, obtaining, establishing and transferring operations as recited in claim 14, except for the viewing device being distinct from the annotation device. Further, the May 18, 2005 Final Office Action asserts that Eberman teaches a database that stores the object identifier and a synchronize circuit that associates the annotation with a portion of the object based on the link and the object identifier. For support, the May 13, 2005 Final Office Action cites col. 2, lines 46-59; col. 3, lines 9-54; col. 7, lines 19-34; col. 16, lines 1-10; col. 20, lines 61-65; col. 21, lines 15-29; and Figs. 1, 7 and 9 of Eberman.

However, the May 18, 2005 Final Office Action asserts, at pages 5 and 8, that Schilit compensates for the deficiencies in Eberman by disclosing a viewing device that is distinct from the annotation device, citing page 252, left column, last paragraph of Schilit.

Appellants respectfully disagree. Schilit teaches that its viewing device and annotation device are one and the same device, and thereby fails to teach or suggest a viewing device that is distinct from the annotation device. Thus, as each of claims 1, 14 and 26 recite this feature, Appellants respectfully submit that the May 18, 2005 Final Office Action does not satisfy the requirements for rejecting the claims under §103 over Eberman and Schilit.

1. Claims 1-13

Eberman and Schilit do not teach or suggest an annotation system that associates annotations with at least one object, the annotation system comprising a viewing device for viewing the at least one object, the viewing device being distinct from an annotation device, a

search circuit that locates the at least one object to be annotated and provides an object identifier that corresponds to the at least one object the annotation device allowing a user to make at least one annotation independently from the at least one object, the annotation device comprising an input device that inputs the at least one annotation, an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object, a database that stores the object identifier, the at least one annotation and the link, and a synchronize circuit that associates the at least one annotation with the at least one portion of the object based on the link and the object identifier, and wherein the user makes annotation using the annotation device while viewing the at least one object using the distinct viewing device, and upon synchronization by the synchronize circuit, the at least one annotation is transferred to the at least one object, as recited in claim 1. This applies by extension to claims 2-13 based on their dependence from claim 1.

For example, the specification discloses various exemplary aspects of an annotation device (100) in Fig. 1 that includes an input/output interface (130), an annotation/link database (140), an annotation linking circuit (150), a synchronize circuit (160) for associating annotations with an object identification and a search circuit (190). The annotation device (100) is connected via a synchronization link (25) to an internet protocol device (10) and a display device (20), as well as to a network (320) that connects to a document storage database (300), an annotation database (310) and to media-type objects (210). As described in the specification and recited in the claims, the annotation device (100) and the display device (20) are separate devices.

A *prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teachings, a reasonable expectation of success, and the references must teach or suggest all the claim

limitations. See MPEP §706.02(j). Appellants respectfully submit that the May 18, 2005 Final Office Action fails to satisfy these criteria based on Eberman and Schilit.

Eberman discloses a system 10A for ranking multimedia annotations. In particular, Eberman teaches the system 10A having annotation clients 18 connected to a network 34 that interacts with audiovisual data 12 through encoder clients 14, a media database 22 through a server 24 and a meta database 26 through a librarian 28. An object database 120 of the meta database 26 includes objects 122, representations 124 of a respective object, and annotations 126 of the object. The annotation client 18 requests a copy of the data 12 from the librarian 28 to generate annotations for an object in the meta database 26 and associated with an identification number. Eberman teaches that the annotations are a collection of values in an annotation structure 110, with time marks 117 and arcs 118 associated with value probabilities for ranking purposes. See col. 4, lines 44-57; col. 7, line 19 – col. 8, line 17; col. 15, lines 12-23, 46 – col. 16, line 10 and Figs. 1A and 7 of Eberman.

As admitted by the May 18, 2005 Final Office Action at paragraph 3(b) on pages 3-4 and agreed to during the January 12, 2005 personal interview with Dr. Spong, Eberman fails to disclose “a viewing device that is distinct from the annotation device.” The Final Office Action asserts that Schilit compensates for this deficiency by disclosing distinct viewing and annotation devices, referring to page 1, Fig. 1 of Schilit. Appellants respectfully disagree.

Schilit discloses an active reading machine based on XLibris. In particular, Schilit teaches a tablet computer that combines a flat-panel display to image the document to be annotated and a “digital ink” stylus with which to make annotation marks on the flat-panel display using XLibris software. The tablet platform can be provided by a Mutoh display. XLibris is implemented in C++ and executed on Windows 95/NT, without using Microsoft widgets. The stylus serves as a “pen” by simulating ink strokes while capable of “dwell” menu selection from pressing the pen at a stationary position. See pages 252, 255 and Figs. 1

and 2 of Schilit. Because Schilit explicitly teaches that both display and annotation of the document are performed concurrently on the tablet, Appellants assert that the Examiner's interpretation of Schilit as teaching distinct devices for these functions is clearly erroneous.

Moreover, because Schilit is designed for a user to make annotations directly on the tablet that displays the document, the XLibris device of Schilit is not intended for, and apparently cannot incorporate, the object database 120 of Eberman that represents each object 122 by object identifiers 124 and associates the object 122 with annotations 126 across the network 34 between the meta database 26 and the annotation client 18.

Appellants respectfully point out that page 255, left column, last paragraph of Schilit provides only that "most previous attempts to improve reading with computation have focused on creating new media ... that redefine the documents being read, as well as the act of reading, placing them in a separate world from existing books and paper documents. This contrasts with our approach of supporting paper practices and paper-based documents." Contrary to the May 18, 2005 Final Office Action assertions, this statement by Schilit teaches away from use of multimedia networked document retrieval and annotation as provided in Eberman.

Thus, there would have been no motivation to combine features related to the annotation ranking of Eberman with the XLibris tablet of Schilit because Schilit teaches away from such features. Accordingly, one of ordinary skill would not have been motivated to combine Schilit with Eberman.

Appellants assert that the Examiner's allegation that it would have been obvious to one of ordinary skill in the art to implement combination of Eberman and Schilit in the May 18, 2005 Final Office Action at paragraph 4(b) on page 9 is merely a conclusory statement, and that no explanation or support for such a conclusion is provided. Further, when relying

on what is asserted to be general knowledge to negate patentability, as apparently set forth at paragraph 4(d) on page 9, that knowledge must be articulated and placed on the record.

Moreover, May 18, 2005 Final Office Action at page 8 characterizes Schilit as disclosing that “the annotation device is a portable personal digital assistant,” although page 252 of Schilit refers only to tablet displays and portable pen computers. Fig. 1 of Schilit clearly shows the pen tablet display operating as a viewing device and simultaneously as an annotation device. The Final Office Action at page 4 and June 29, 2005 Advisory Action at page 2 both assert that Schilit teaches “a viewing device that is distinct from the annotation device.” However, the Examiner’s position relies on the pen tablet display of Schilit as both the display device and the annotation device. Thus, as submitted in Appellants’ August 18, 2005 Pre-Appeal Brief Request for Review, the May 18, 2005 Final Office Action is factually deficient in asserting that Schilit teaches the viewing and annotation devices as being distinct devices.

2. Claims 14-37

Moreover, Eberman and Schilit fail to teach or suggest a method for associating annotations with at least one object comprising searching for the at least one object to annotate, obtaining an object identifier for the at least one object, generating at least one annotation using an annotation device and an input device that is distinct from the annotation device, while displaying the at least one object with a viewing device that is distinct from the annotation device, establishing a link associating the at least one annotation with the object, transferring the at least one annotation to the at least one object by associating the at least one annotation with the at least one object based on the link and the at least one object identifier, as recited in claim 14, and similarly recited for an information storage media recited in claim 26. This applies by extension to claims 15-25 based on their dependence from claim 14 and to claims 27-37 based on their dependence from claim 26.

As discussed above, Appellants respectfully submit that Schilit teaches that its viewing device and annotation device are one and the same device, and thereby fails to teach or suggest a viewing device that is distinct from the annotation device, thus failing to remedy the admitted deficiency of Eberman.

3. Conclusion

In view of the foregoing, Appellants respectfully submit that the Final Office Action does not satisfy the burden for rejection under §103 with Eberman and Schilit. Appellants respectfully submit that the May 18, 2005 Final Office Action mischaracterizes the teachings of the applied references, as described above, and thus reaches an invalid and unwarranted conclusion that all the features recited in the claims are taught or suggested by Eberman and Schilit. Further, Appellants respectfully submit that the Final Office Action has not established a proper motivation to combine Schilit and Eberman for a *prima facie* case of obviousness. Appellants therefore respectfully submit that the rejection of claims 1-37 under 35 U.S.C. §103(a) is improper and should be reversed.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-37 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1-37 and pass this application to issue.

Respectfully submitted,

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Attachments:

Appendix A - Claims Appendix
Appendix B - Evidence Appendix
Appendix C - Related Proceedings Appendix

APPENDIX A - CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. An annotation system that associates annotations with at least one object, the annotation system comprising:
 - a viewing device for viewing the at least one object, the viewing device being distinct from an annotation device;
 - a search circuit that locates the at least one object to be annotated and provides an object identifier that corresponds to the at least one object;
 - the annotation device allowing a user to make at least one annotation independently from the at least one object, the annotation device comprising:
 - an input device that inputs the at least one annotation;
 - an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object;
 - a database that stores the object identifier, the at least one annotation and the link; and
 - a synchronize circuit that associates the at least one annotation with the at least one portion of the object based on the link and the object identifier, ; and
 - wherein the user makes annotation using the annotation device while viewing the at least one object using the distinct viewing device, and upon synchronization by the synchronize circuit, the at least one annotation is transferred to the at least one object.
2. The system of claim 1, wherein the annotation linking circuit establishes the link to the at least one portion based on at least one of a graphical technique and a textual technique.

3. The system of claim 2, wherein the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object.

4. The system of claim 2, wherein the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text.

5. The system of claim 4, wherein the textual technique is based on a phrase completion technique.

6. The system of claim 1, wherein the search circuit is located in at least one of the annotation device, a personal computer and a networked search engine.

7. The system of claim 1, wherein the search circuit receives at least one of the object identifier and one or more key words corresponding to the object to be annotated.

8. The system of claim 1, further comprising an annotation database that stores the at least one annotation and the object identifier for the at least one object.

9. The system of claim 8, wherein the annotation database is located on a distributed network.

10. The system of claim 8, wherein the annotation database stores at least one annotation previously associated with the at least one object.

11. The system of claim 1, wherein the at least one object is at least one of a media type object, a device type object, a location type object and a digital document.

12. The system of claim 1, wherein the annotation device is a portable personal digital assistant, which can be decoupled from the object when the annotation is made.

13. The system of claim 1, wherein the object identifier is collocated with the at least one object.

14. A method for associating annotations with at least one object comprising:

searching for the at least one object to annotate;

obtaining an object identifier for the at least one object;

generating at least one annotation using an annotation device and an input device that is distinct from the annotation device, while displaying the at least one object with a viewing device that is distinct from the annotation device;

establishing a link associating the at least one annotation with the object;

transferring the at least one annotation to the at least one object by associating the at least one annotation with the at least one object based on the link and the at least one object identifier.

15. The method of claim 14, wherein associating at least one annotation with at least one portion of the object is based on at least one of a graphical technique and a textual technique.

16. The method of claim 15, wherein the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object.

17. The method of claim 15, wherein the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text.

18. The method of claim 17, wherein the textual technique is based on a phrase completion technique.

19. The method of claim 14, further comprising associating the object identifier and the at least one object.

20. The method of claim 14, further comprising retrieving supplemental information associated with the at least one object.

21. The method of claim 14, further comprising developing a digital surrogate of the at least one object.

22. The method of claim 14, further comprising retrieving at least one previous annotation associated with the at least one object.

23. The method of claim 22, further comprising annotating the at least one object while the annotation device is decoupled from the object.

24. (Original) The method of claim 14, wherein searching for the at least one object comprises:

entering at least one of a description of the object and the object identifier; and
searching at least one of a networked search engine, a personal computer and a distributed network.

25. The method of claim 14, wherein the at least one object is at least one of a media type object, a device type object, a location type object and a digital document.

26. An information storage media that stores a control program for associating annotations with at least one object, the control program including instructions for:

searching for the at least one object to annotate;
obtaining an object identifier for the at least one object;
generating at least one annotation using an annotation device and an input device while displaying the at least one object and the at least one annotation with a viewing device that is distinct from the annotation device;
establishing a link associating the at least one annotation with at least one portion of the object; and

transferring the at least one annotation to the at least one object by associating the at least one annotation with the at least one object based on the link and the at least one object identifier.

27. The information storage media of claim 26 wherein the instructions for associating at least one annotation with at least one portion of the object are based on at least one of a graphical technique and a textual technique.

28. The information storage media of claim 27, wherein the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object.

29. The information storage media of claim 27, wherein the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text.

30. The information storage media of claim 29, wherein the textual technique is based on a phrase completion technique.

31. The information storage media of claim 26, the control program further including instructions for associating the object identifier and the at least one object.

32. The information storage media of claim 26, the control program further including instructions for retrieving supplemental information associated with the at least one object.

33. The information storage media of claim 26, the control program further including instructions for developing a digital surrogate of the at least one object.

34. The information storage media of claim 26, the control program further including instructions for retrieving at least one previous annotation associated with the at least one object.

35. The information storage media of claim 34, the control program further including instructions for annotating at least one of the at least one previous annotation.

36. The information storage media of claim 26, the instructions for searching for the at least one object further include instructions for:

specifying at least one of a description of the object and the object identifier;

and

searching at least one of a networked search engine, a personal computer and a distributed network.

37. The information storage media of claim 26, wherein the at least one object is at least one of a media type object, a device type object, a location type object and a digital document.

APPENDIX B -EVIDENCE APPENDIX

None.

APPENDIX C -RELATED PROCEEDINGS APPENDIX

None.